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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/092,560	03/08/2002	Ernesto E. Blanco	217395US25CIP	2081
22850 7590 12/12/2007 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER MACNEILL, ELIZABETH	
			ART UNIT 3767	PAPER NUMBER
			NOTIFICATION DATE 12/12/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
oblonpat@oblon.com  
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## Office Action Summary

Application No.

10/092,560

Applicant(s)

BLANCO, ERNESTO E.

Examiner

Elizabeth R. MacNeill

Art Unit

3767

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15, 17-20, 22-25, 27, 31-50, 91, 96-235 and 245-260 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-15, 17-20, 22-25, 27, 31-50, 91, 96-235, 245-260 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claim 1,212: a handle; penetrator; cannula; blade and guard
  - II. Claim 5,184,185: handle; penetrator; blade; guard; insufflation passageway
  - III. Claim 13,158,161,224,227: a handle; penetrator; cannula; blade and guard; expander
  - IV. Claim 20,42,119,131,156,160,231,248: a handle; penetrator; blade and guard; expander
  - V. Claim 22,233: handle; penetrator; blade; guard; lock
  - VI. Claim 23,234: handle; penetrator; blade; guard; side horn
  - VII. Claim 25: handle; penetrator; blade; guard;
  - VIII. Claim 34: a handle; penetrator; cannula; blade and guard; expander; insufflation passageway
  - IX. Claim 36,218: handle; penetrator; blade; guard; insufflation passageway; reservoir; check valve
  - X. Claim 37 and 39: handle; penetrator; blade; guard; expander; single blades
  - XI. Claim 38: handle; penetrator; blade; guard; expander; penetration monitor
  - XII. Claim 40: a handle; penetrator; cannula; blade and guard; expander; lock
  - XIII. Claim 41: handle; penetrator; blade; guard; expander; side horn

- XIV. Claim 47,49,50;159;245: handle; penetrator; blade; guard; insufflation passageway; expander
- XV. Claim 48: handle; penetrator; cannula; blade; guard; insufflation passageway; expander
- XVI. Claim 96;109,138,140;253: penetrator; blade; guard; insufflation passageway
- XVII. Claim 113,249: penetrator; cannula; blade and guard;
- XVIII. Claim 120,148: penetrator; blade; guard
- XIX. Claim 127: penetrator; blade; guard; lock
- XX. Claim 129: penetrator; blade; guard; expander; side horn
- XXI. Claim 134: penetrator; blade; guard; insufflation passageway; expander
- XXII. Claim 143,151,216,255: penetrator; blade; guard; cannula; insufflation passageway
- XXIII. Claim 145: penetrator; blade; guard; insufflation passageway; reservoir; check valve
- XXIV. Claim 153: penetrator; blade; guard; cannula; lock
- XXV. Claim 154: a handle; penetrator; cannula; blade and guard; expander; side horn
- XXVI. Claim 162: penetrator; blade; guard; cannula; insufflation passageway
- XXVII. Claim 163: penetrator; cannula; insufflation passageway
- XXVIII. Claim 164,170,174,180: penetrator; blade; guard
- XXIX. Claim 172,182: handle; penetrator; blade; guard; lock

- XXX. Claim 186: penetrator; blade; guard; lock
- XXXI. Claim 194: a handle; penetrator; cannula; blade and guard; lock
- XXXII. Claim 204: a handle; penetrator; cannula; guard;
- XXXIII. Claim 247: handle; penetrator; blade; guard; insufflation passageway;  
expander; reservoir
- XXXIV. Claim 257,258: penetrator; blade; guard; cannula; expander
- XXXV. Claim 260: penetrator; blade; guard insufflation passageway; expander;  
reservoir; check valve
- XXXVI. Claim 198: method of using guard and blade to pierce
- XXXVII. Claim 200: method of using a locking and unlock guard and shield
- XXXVIII. Claim 207: method of using a device with first and second tubes to pierce
- XXXIX. Claim 209: method of using a blade with left and right edges.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions (I-XXVI) and (XXXV-XXXIX) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the process can be practiced with a materially different product, such as a trocar with insufflation, check valves, cannulas, or handles

3. Inventions I-XXVI are directed to related products. The related inventions are distinct if the (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j). In the instant case, the inventions as claimed all have materially different designs. Furthermore, the inventions as claimed do not encompass overlapping subject matter and there is nothing of record to show them to be obvious variants.

4. Inventions XXV-XXXIX are directed to related process. The related inventions are distinct if the (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j). In the instant case, the inventions as claimed have a materially different mode of operation as detailed above. Furthermore, the inventions as claimed do not encompass overlapping subject matter and there is nothing of record to show them to be obvious variants.

5. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

6. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art due to their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth R. MacNeill whose telephone number is (571)-272-9970. The examiner can normally be reached on 9:00-5:30 M-F.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Sirmons can be reached on (571) 272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ERM

Handwritten signature of ERM, likely a representative of the USPTO.

KEVIN C. SIRMONS  
SUPERVISORY PATENT EXAMINER

Handwritten signature of Kevin C. Sirmons, Supervisory Patent Examiner.